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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/738,444	12/17/2003	Philip Wills	624-34814US (102.65)	8089

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Keith R. Derrington
Simmons & Derrington, L.L.P.
Frost Bank Building
6750 West Loop South, Suite 920
Bellaire, TX 77401

EXAMINER

SMITH, MATTHEW J

ART UNIT	PAPER NUMBER
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3672

DATE MAILED: 09/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/738,444	Applicant(s) WILLS, PHILIP	
	Examiner Matthew J. Smith	Art Unit 3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8, 10-12 and 15-23 is/are rejected.
- 7) ☒ Claim(s) 6, 7, 9, 13, 14, and 24-26 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>17Dec03</u> . | 6) <input type="checkbox"/> Other: ____. |

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "34" has been used to designate both hanging plate [0023] and inner piston [0024]; character "36", inner piston [0021], outer piston [0024], and shear screws [0026].

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 60 (figure 7); theta (figure 3), described as 0 in [0022].

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: flow path 61 [0032], should be --60--; angle 0 [0022], should be --theta--.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 9 is objected to because of the following informalities: "said first and second piston" lacks antecedent basis. Previously, in claims 5 and 20, only a first piston was recited. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 17-19, and 21-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Wittrisch (4660635).

Wittrisch discloses an elongated tubular member 1 having a first end, a second end, an outer surface, and an inner surface for use in a wellbore operation; an aperture 5 formed through the tubular member providing communication between the outer surface and the inner surface; a line cutting apparatus 8 within the elongated tubular member; a line 3 disposed through the aperture; and the line cutter is a hydraulically actuated cutter.

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This reference also discloses a method of use comprising connecting a side entry sub 2 to a drill string tubular 1a; threading a line 3 through the sub and tubular to a tool (col. 2 line 49); cutting the line 3 with a cutting surface (beveled section, col. 3, lines 4-5) on a sleeve or piston 8; removing the cutting assembly from the well (when pulling the drill string); and threading line 3 through aperture 5

Claims 5, 8, 10-12, 15, 16, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Lawrence et al. (2794619).

Lawrence et al. disclose a cutting assembly for cutting a line comprising: an elongated housing 10 having an outer surface and an inner surface; rod 30; a first piston 28 slidably attached to the rod within the housing; a cutting blade 12 fixed on the rod wherein axial displacement of the piston along the rod urges the cutting blade toward the line; shoulder 30b on the rod; the rod comprises a first section 30 and a second section 30a, wherein the diameter of the second section is greater than the diameter of the first section thereby providing the capability of increasing the differential pressure across the first piston as the first piston passes from the first section to the second section; a line F disposed within the line cutting assembly; a slip 14 securing contact with the line; the cutting assembly disposed within a pipe string C; and an aperture (figure 2a).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Wittrisch in view of Lawrence.

Wittrisch discloses an elongated tubular member 1 having a first end, a second end, an outer surface, and an inner surface for use in a wellbore operation; an aperture 5 formed through the tubular member providing communication between the outer surface and the inner surface; and a line cutting apparatus 8 within the elongated tubular member but not a slip securing contact with the line.

Lawrence et al. present a slip 14 securing contact with the line.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to add a slip to the Wittrisch device in order to better hold the line prior to cutting.

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Allowable Subject Matter

Claims 6, 7, 9, 13, 14, and 24-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Smith whose telephone number is 571-272-7034. The examiner can normally be reached on T-F, 9-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David Bagnell
Supervisory Patent Examiner
Art Unit 3672

MJS *MJS*
13 September 2005